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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,697	01/16/2004	Hironobu Hoshino	B-5358 621657-8	8445
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EXAMINER TODD, GREGORY G				
ART UNIT 2157		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,697

Applicant(s)

HOSHINO, HIRONOBU

Examiner

GREGORY G. TODD

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date 1/16/04 07/05/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is a first office action in response to application filed, with the above serial number, on 16 January 2004 in which claims 1-31 are presented for examination. Claims 1-31 are therefore pending in the application.

Specification

2. The attempt to incorporate subject matter into this application by reference to Japanese Patent Hei-8-263409 is ineffective because (*e.g., the root words "incorporate" and/or "reference" have been omitted*).

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication, is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

The incorporation by reference will not be effective until correction is made to comply with 37 CFR 1.57(b), (c), or (d). If the incorporated material is relied upon to meet any outstanding objection, rejection, or other requirement imposed by the Office, the correction must be made within any time period set by the Office for responding to

the objection, rejection, or other requirement for the incorporation to be effective.

Compliance will not be held in abeyance with respect to responding to the objection, rejection, or other requirement for the incorporation to be effective. In no case may the correction be made later than the close of prosecution as defined in 37 CFR 1.114(b), or abandonment of the application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. 37 CFR 1.57(f).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 recites the limitation "the mobile communication apparatus" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

The term "high precision/ excellent sensitivity" in claim 11 is a relative term which renders the claim indefinite. The term "high precision/ excellent sensitivity" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 12 recites the limitation "the high synchronizing performance" in line 3.

There is insufficient antecedent basis for this limitation in the claim.

The term "optimal to a unique information" in claim 13 is a relative term which renders the claim indefinite. The term "optimal to a unique information" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 14 recites the limitation "the multipath disturbance" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 18 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the term 'adaptable' makes the claim indefinite as it is not clear as to the limit of adaptability.

Claim 11 and 22 recite the limitation "the current communication software" in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. As per Claims 1-27 and 30.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of

steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material per se.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided.

The claim scope is undetermined as a reasonable interpretation of the claims can refer to embodiments which are just software or a program per se.

6. Claims 28-29 and 31 are directed to "an information recording medium".

According to the October 26, 2005 Interim Guidelines for Examining Patent Applications, signal claims are ineligible for patent protection because they do not fall within the four statutory classes of § 101. (See

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf). The

specification does not provide guidelines limiting what a medium is confined to, thus the medium broadly encompasses a signal medium without the use of terminology such as a "computer readable storage medium".

In order to expedite a comprehensive examination of the instant application, the claims rejected under 35 U.S.C.101 (non-statutory) above, are further rejected as set forth below in anticipation of applicant amending these claims to place them within the admissible statutory categories of invention.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-6, 8-10, 18-26, and 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Ji et al (hereinafter "Ji", 6,836,657).

As per Claim 1, Ji teaches a software download system for downloading a communication software from a download center with which a communication apparatus is connected via a communication line, wherein the communication apparatus comprises:

software storage unit which stores the communication software (at least col. 4:45-67 client devices storing electronic files);

a request information generating unit which generates request information indicating at least a status of the communication apparatus by recognizing the status of the communication apparatus (at least col. 4:10-29; 8:29-40; client device processor determining device status');

a request information transmitting unit which transmits the request information to the download center (at least col. 7:33-45; eg. confirmation from handset/ client device);

a software receiving unit which receives the communication software transmitted from the download center (at least col. 7:33-64; client device upgrade from upgrade server);

a software rewrite control unit which rewrites contents of the software storage unit with the received communication software (at least col. 4:45-67; upgrading original file); and

a communication unit which executes the stored communication software (at least col. 4:10-67; client devices using stored files), and

the download center comprises:

a software accumulating unit which accumulates different kinds of communication software (at least col. 4:45-50; host system/ server database having versions of electronic files);

a request information receiving unit which receives the request information of the communication apparatus (at least col. 7:32-45; upgrade server authenticating requesting device);

a software selecting unit which selects a suitable communication software from the software accumulating unit in accordance with the received request information (at least col. 7:32-45; identify and transfer appropriate files); and

a software transmitting unit which transmits the selected communication software to the communication apparatus (at least col. 7:10-31; transfer upgrade file to device).

As per Claim 2. The software download system according to claim 1, wherein the communication unit has a function of receiving broadcast, and the communication software is a receiving software (at least col. 4:52-67; 7:20-30; eg. new file from software provider, server sending notification).

As per Claim 3. The software download system according to claim 2, wherein the communication unit has a function of receiving different kinds of broadcast, and the communication apparatus further comprises a received broadcast switching unit which switches the kind of broadcast received by the communication unit (at least col. 7:20-30; different user notification protocols).

As per Claim 4. The software download system according to claim 1, wherein the communication unit has a function of the mobile communication apparatus (at least Fig. 2; 122).

As per Claim 5. The software download system according to claim 1, wherein the communication apparatus further comprises a request information transmission judging unit which judges whether or not the request information should be transmitted to the download center (at least col. 8:29-40; client device pre-qualification).

As per Claim 6. The software download system according to claim 1, wherein the download center further comprises a software transmission judging unit which judges whether or not the selected communication software should be transmitted to the communication apparatus (at least col. 7:10-18; eg. upgrade server authenticating mobile client devices).

Claims 8-10, 18-26, and 28-31 do not, in substance, add or define any additional limitations over claims 1-6 and therefore are rejected for similar reasons.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 17, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ji in view of Souissi (hereinafter "Souissi", 2002/0068608).

As per Claim 7. Ji fails to teach wherein the communication apparatus further comprises a position information acquiring unit which acquires a position information of the

communication apparatus, and the request information generating unit makes the request information include the position information, and wherein the download center further comprises a community information database, and the software selecting unit refers to the community information database based on the position information included in the request information and selects a suitable communication software in consideration of a communication environment based on the position of the communication apparatus. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Souissi. Souissi teaches, in a similar endeavor, a host computer having a geographic database to configure a mobile device based on the device location (at least paragraph 49-52). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the use of Souissi's location based reconfiguration with Ji as Souissi teaches different locations requiring different operational configurations of the device to operate, for example, what technologies and frequency bands are supported in a given location. The claim would have been obvious because the technique for improving a particular class of devices was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations, and as Ji teaches using different protocols for device notification, it would have been obvious to use the appropriate protocol given the location's capabilities.

Claims 17 and 27 do not add or define any additional limitations over claim 7 and therefore are rejected for similar reasons.

11. Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ji.

As per Claim 11, Ji fails to explicitly teach wherein the request information generating unit generates request information to make a request for communication software with a high precision of arithmetical operation that can receive a receiving signal at excellent sensitivity, when the power level of the receiving signal is different from the supposed power level for the current communication software. However, OFFICIAL NOTICE is taken that the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made. Ji teaches mobile devices communicating over wireless communication links (col. 1:45-55), and receiving upgrade and update software files of various magnitude (col. 4:60-67), and it would have been obvious that such updates/revisions from a software provider (col. 6:10-35) would offer capabilities to have the mobile device operate in a more effective and efficient manner.

As per Claim 12, Ji fails to explicitly teach wherein the request information generating unit generates request information to make a request for communication software with the high synchronizing performance, when the receiving signal is likely to be out of synchronization. However, OFFICIAL NOTICE is taken that the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made. Ji teaches mobile devices communicating over wireless communication links (col. 1:45-55), and receiving upgrade and update software files of various magnitude (col. 4:60-67), and it would have been obvious that such updates/revisions from a

software provider (col. 6:10-35) would offer capabilities to have the mobile device operate in a more effective and efficient manner.

As per Claim 13. Ji fails to explicitly teach wherein the request information generating unit generates request information to make a request for communication software optimal to a unique information, when the unique information for the receiving signal is obtained. However, OFFICIAL NOTICE is taken that the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made. Ji teaches mobile devices communicating over wireless communication links (col. 1:45-55), and receiving upgrade and update software files of various magnitude (col. 4:60-67), and it would have been obvious that such updates/revisions from a software provider (col. 6:10-35) would offer capabilities to have the mobile device operate in a more effective and efficient manner.

As per Claim 14. Ji fails to explicitly teach wherein the request information generating unit generates request information to make a request for communication software suitable for removal of the multipath, when the multipath disturbance is recognized. However, OFFICIAL NOTICE is taken that the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made. Ji teaches mobile devices communicating over wireless communication links (col. 1:45-55), and receiving upgrade and update software files of various magnitude (col. 4:60-67), and it would have been obvious that such updates/revisions from a software provider (col. 6:10-35) would offer capabilities to have the mobile device operate in a more effective and efficient manner.

As per Claim 15. Ji fails to explicitly teach wherein the request information generating unit generates request information to make a request for communication software with a higher ability of correcting errors, when the receiving signal has a high Bit Error Rate. However, OFFICIAL NOTICE is taken that the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made. Ji teaches mobile devices communicating over wireless communication links (col. 1:45-55), and receiving upgrade and update software files of various magnitude (col. 4:60-67), and it would have been obvious that such updates/revisions from a software provider (col. 6:10-35) would offer capabilities to have the mobile device operate in a more effective and efficient manner.

As per Claim 16. Ji fails to explicitly teach wherein the request information generating unit generates request information to make a request for communication software with a decoding program suitable for a multiple signal, when the information indicating that the receiving signal is the multiple signal is obtained. However, OFFICIAL NOTICE is taken that the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made. Ji teaches mobile devices communicating over wireless communication links (col. 1:45-55), and receiving upgrade and update software files of various magnitude (col. 4:60-67), and it would have been obvious that such updates/revisions from a software provider (col. 6:10-35) would offer capabilities to have the mobile device operate in a more effective and efficient manner.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Costello et al, Choi et al, and Leppanen are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY G. TODD whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm w/ first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/759,697
Art Unit: 2157

Page 15

/Gregory G Todd/
Examiner, Art Unit 2157